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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,960	12/22/2000	Michael Strobel	02581-P0350A	8504

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EXAMINER

FERKO, KATHRYN P

ART UNIT	PAPER NUMBER
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3743

DATE MAILED: 07/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,960

Applicant(s)

STROBEL ET AL.

Examiner

Kathryn Ferko

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 15-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 15-19 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 December 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, claims 1-14, in Paper No. 7 is acknowledged.

Specification

2. The disclosure is objected to because of the following informalities: on the last line of page 16, transplant is labeled element 102 and bore channel is also labeled element 102. Each element should only have one label and each label should only refer to one element.

Appropriate correction is required.

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Since there are many screws for medical purposes, a novel feature of the invention should be included in the title.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: element 46 or 74. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-6, 8, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Jammet et al. in US Patent No. 5,941,882.

Jammet et al. disclose a screw (120) for medical purposes having a screw body having a head portion having a facial end face, a shaft portion extending from the head portion from an end opposite to the facial end face along an axial direction of the screw body, a threading (116) provided on an outer side of the shaft portion, as recited in column 4, lines 20-40 and seen in figures 5-8; at least one axially extending groove (118) cut into an outer side of the screw body, as seen in figures 5 and 6; at least one groove extending along the head portion and an entire length of the shaft portion, as seen in figures 5 and 6; at least one groove (118) being provided for inserting a drive element of a driving tool therein,

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such as that shown in figure 8; a depth of the at least one axial groove is such that the drive element of the driving tool lies within the at least one axially groove and does not extend beyond an outer periphery of the screw body, as seen in figures 6 and 8 (where size of 150 will fit that if 118 and not extend beyond); a depth of the at least one axially groove that is such that the drive element of the driving tool is housed within the groove without extending radially beyond the threading of the shaft portion, as seen in figures 6 and 8; at least one recess (122) that is provided in the facial end face of the head portion, [where given the structure a corresponding projection on the tool **can** be introduced into the recess for centering the tool on the screw – Furthermore, functional language is not given patentable weight in an apparatus claim.]; a recess (122) that is configured as a channel completely passing through the screw body, as seen in figure 5; several axially extending grooves (118) that are provided to be distributed uniformly about a circumference of the screw body, as seen in figures 5 and 6; at least one axially extending groove is open axially at the facial end face end of the head portion, as seen in figure 5 and 6; a screw that is configured as an interference screw for anchoring a transplant in an opening in a bone, as recited in column 1, lines 59-67; and a transplant is selected from the group consisting of a tendon and a ligament, as recited in column 4, lines 59-67.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 7, 9, 10, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jammet et al. in US Patent No. 5,941,882.

Jammet et al. disclose the invention with the exception of up to five axially extending groove that are provided to be distributed uniformly about a circumference of the screw body; a bridge that is provided for bridging the at least axially extending groove in a circumferential direction; a bridge that is provided in the head portion of the screw body; a bridge that is formed by the outer threading of the shaft portion; and a screw that is made of a biodegradable material.

On the other hand, it would be obvious to one with ordinary skill in the art to modify the invention to have up to five axially extending groove that are provided to be distributed uniformly about a circumference of the screw body. The current application specification does not demonstrate the criticality of having up to five grooves. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention to have numerous grooves where it would be system dependent based on the application.

Moreover, a bridge that is provided for bridging the at least axially extending groove in a circumferential direction; a bridge that is provided in the head portion of the screw body; and a bridge that is formed by the outer threading of the shaft portion would also be obvious to one with ordinary skill in

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the art and considered a matter of design choice. Again, the current specification does not provide criticality to the bridge.

Furthermore, a screw that is made of a biodegradable material would also be obvious to one with ordinary skill in the art as common in the art.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure are as follows: US Patent No. 6,454,772; US Patent No. 6,402,757; US Patent No. 6,165,203; US Patent No. 6,019,768; US Patent No. 5,131,795; US Patent No. 3,911,781; and US Patent No. 3,866,510.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kathryn Ferko whose telephone number is (703) 306-3454. The examiner can normally be reached on M-F (7:30-5:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A Bennett can be reached on (703) 308-0101. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

KF
June 23, 2003


Henry Bennett
Supervisor Patent Examiner
Group 3700